

**Remarks-General**

By the above amendment, applicant has amended the drawings and has rewritten all claims to define the invention more particularly and distinctly so as to overcome the technical rejections and define the invention patentable over prior art.

Drawings have also been numerically corrected.

**The claims rejection under 35 U.S.C. 112 Claims 1-3**

Claims 1-3 have been canceled and new claims 4 and 5 have been written to describe how the elements mentioned are structurally related to each other.

**The rejection of Claims 1 on Channell Overcome**

The last O.A. rejected claim 1 on Channell. Claim 1 has been rewritten as new claim 4 to define patentability over these references, and any combination thereof. Applicant requests reconsideration of this rejection, as now applicable to claim 4, for the following reasons.

The office action sights on page 9 lines 1-3 as Channell, disclosing a "level devise" to be used when installing doorjambs, comprising a solid 90 degree right angle square (10,26) having a "tube" portion (24), and an I-beam level jamb(12)

- (1) The office action improperly describes Channels 90 degree right angle to be a "one piece" square when it clearly has four combined and distinct parts two of 24 one of 26 and a plurality of screws 30 (Column 2 of Channell lines 45-48 and figure 4 (30) and (Column 3 lines 1-6)

- (2) Channell describes (24) connector members as solid (Column 2 of Channell, line 53) verse “tube” shaped as the office action indicates.
- (3) Channell improperly describes an “L shaped” attachment, claimed as “right angle”connector arm (Column 4 of Channell, lines 12,20-21) in practical use the connection between the elongated arm member in figure 4 #24 and the extended arm (figure 2 # 26) will move due to the length and leverage imposed on said connection. Furthermore the connector members fig 2(24) in relation to the elongated pockets fig.3 (22) have no means for remaining parallel which is critical for the attachment to remain at 90 degrees in relation to the I-beam level. A deviation of any degree renders the description “right angle square” inaccurate. For this reason, in the field of precision woodworking “true” 90 degree right angle squares are one piece designs. The applicants invention is a novel, “one piece” 90 degree square and rectangular box beam extension combined successfully for the first time.

**The rejection of claim 2 on Channell Overcome**

The last O.A. rejected claim 2 on Channell. Claim 2 has been rewritten as new claim 5 to define patentability over this reference. Applicant request reconsideration of this rejection, as now applicable to claim 5 for the following reasons.

The office action sights on page 9 lines 4-8 that Channell discloses a device which will perform the step of inserting a solid 90 degree right angle square into an I-Beam level.

- (1) The applicants novel claims refer specifically to inserting a “one Piece” 90 degree square into a rectangular sleeve shaped box beam extension tube.
- (2) Channel also improperly describes an attachment invention, clearly specific to a “custom” manufactured Level to receive it, (in his words) an attachment to “a conventional Carpenters level with an I-beam cross section.(Channel column 2 line 26-29) In practical use the embodying principal of the invention will not work with a conventional carpenters level of slightly different manufactures specifications or measurements.

- a. **Inoperative References:** The prior art references that were relied upon are inoperative.
- b. **Unexpected Results:** The results achieved by the invention are new, unexpected, superior, disproportionate, unsuggested, unusual, critical, and /or surprising.
- c. **Solution of Long-Felt and Unsolved Need.** The invention solves a long-felt, long existing but unsolved need.

**Channell and Drumright Do Not Contain Any Justification To Support Their Combination, Much Less In The Manor Proposed.**

The office action sights (page 9 the last paragraph and page 10 first paragraph) obviousness and no invention by shifting (In re Japikse, 86 USPQ 70 CCPA 1950) the

position of the I-beam level and tube portion disclosed by Channell with a connection having a box beam jamb tube receiving an I-Beam portion as taught by Drumright.

With regard to the proposed combination of Channell and Drumright, these references fail to suggest a combination of the applicant's invention since the Channell reference would require substantial and critical modification in order to be compared to the applicant's invention.

It is well known that in order for any prior art reference themselves to be validly combined for use in prior art 103 rejection, *the references themselves* (or some other prior art ) must suggest that they combine. E.g., as was stated in In re Sernaker, 217 U.S.P.Q. 1,6 (C.A.F.C. 1983):

“Prior art references in combination do not make an invention obvious unless something in the prior art would suggest the advantages to be derived from combining there teachings.”

More recently the Board stated in Ex parte Levengood, 28 USPQ 2d 1300(P.T.O.B.A.&I. 1993):

“In order to establish a *Prima facie* case of obviousness, it is necessary for the examiner to present *evidence*, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been lead* to combine the relevant teachings of the, applied references in the proposed manner to arrive at the claimed

invention... That which is within the capabilities of one skilled in the art is not synonymous with obviousness... That one can *reconstruct* and /or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies *sufficient impetus* to have led one of the ordinary skill in the art to combine the teachings of the references to make the claimed invention... Our reviewing courts have often advised the PTO that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that “would lead” that individual to combine the relevant teachings of the references... Accordingly an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant’s invention without also providing *evidence of motivating force* which would impel one skilled in the art to do what the patent applicant has done”

Applicant therefore submits that combining Channell and Drumright is not legally justified and is therefore improper. Thus they submit that the rejection on these references is also improper and should be withdrawn.

Applicant respectfully request, if the claims are again rejected upon any combination of references, that the Examiner include an explanation, in accordance with M.P.E.P.

706.02. Ex parte Clapp, 27 U.S.P.Q. 972 (P.O.B.A. 1985) and Ex parte Levngood, *supra*, a “factual basis to support his conclusion that would have been obvious” to make the combination.

**Even If Channell and Drumright Were To Be Combined In The Manor Proposed, The Proposed Combination Would Not Show All The Novel Physical Features Of Claim 4 (a&b) and 5**

However even if the combination of Channell and Drumright were legally justified, claims 4 (a&b) and 5 would still have novel (and unobvious ) physical features over the proposed combination. In other words, applicants invention, as defined by claims 4(a&b) and 5 comprise much more than merely shifting the position of the I-beam disclosed by Channell with the box beam jamb tube receiving an I-beam portion as taught by Drumright.

**The Novel Physical Features of Claims 4 (a&b) and 5 Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over These References Under 103**

Also applicant submit that the novel physical features of claim 4(a&b) and 5 are also unobvious and hence patentable under 103 since they produce new and unexpected results over Channell and Drumright, or any combination thereof.

These new and unexpected results are the ability of the applicants device to maintain a precise and true 90 degree right angle square that is adjustable in length and width and is reversible for use in either right or left swing doors. Other unexpected results include but are not limited to; elimination of jamb twisting, and warping that would result in "Hinge Bound" doors. Elimination of out of square door jambs that would result in improper clearances around the door, and successful installation of interior doorjambs in half the

time of all other known methods. Applicant invention therefore is vastly superior to that of either Channell and Drumright, or any possible combination thereof.

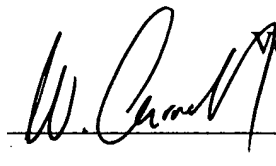
**Lack of Implementation:** If the invention were in fact obvious because of it's advantages, those skilled in the art surely would have implemented it by now. That –is the fact that those skilled in the art have not implemented the invention, despite it's great advantages, indicates that it is not obvious.

**Conclusion:**

For all the above reasons, applicant submits that the specification and claims are now in proper form, and that the claims all define patentability over the prior art. Therefore they submit that this application is now in condition for allowance, which action they respectfully solicit.

**Conditional Request For Constructive Assistance:**

Applicant has amended the specification and claims of this application so that they are proper, definite, and define novel structure which is also unobvious. If for any reason this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. 2173.02 and 707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Very respectfully,  
 Dated 6/19/05

William P. Carroll

Applicant Pro Se

1121 S. Military Trail # 248

Deerfield Beach Fl, 33442-7645

774-236-9320 Cell

561-208-1475 Home

**Certification of service:** I certify that on June 25<sup>th</sup> 2005 I mailed this response

to: Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia

A handwritten signature in black ink, appearing to read "W. P. Carroll". The signature is written in a cursive, flowing style.

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